

Application No. 09/218,781
Amendment "A" dated August 29, 2005
Reply to Office Action mailed May 27, 2005

REMARKS / ARGUMENTS

The present Amendment is in response to the Office Action mailed May 27, 2005. Claims 1, 7, 13, and 18 are amended, and claims 1-21 are now pending in view of the above amendments.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding. Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Examiner's Interview

Applicant's express their appreciation to the Examiner for conducting an interview with Applicants representative on August 16, 2005. This response includes the substance of the interview.

Rejections Under 35 U.S.C. § 101

The Office Action rejected claim s 1-21 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. As discussed at the interview, the independent claims have been

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amended overcome the rejection under § 101. Claim 1, for example, requires "issuing a limited-use account number associated with the account at a computer in the computer system." While Applicants assert that the claims as originally filed were directed to statutory subject matter, this amendment to claim 1 and similar amendments to claims 7, 13, and 18 further clarifies that claims 1-21 are directed to statutory subject matter. Withdrawal of the rejection under 35 U.S.C. § 101 is respectfully requested.

Rejections Under 35 U.S.C. § 102

The Office Action rejected claims 1-11 and 13-21 under 35 U.S.C. § 102(c) as being anticipated by U.S. Patent No. 6,422,462 (*Cohen*)¹. Anticipation requires that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The following discussion illustrates *Cohen* does not satisfy the requirements of *Verdegaal* with respect to claims 1-11 and 13-21.

Cohen is directed to improved credit cards and credit card transactions and discloses a system of disposable credit card numbers to address the problem of credit card fraud. See col. 2, lines 32-34. In order to practice the invention of *Cohen*, a "user dials into her credit card company before making a transaction." See col. 3, lines 41-45. As part of the call, the user is required to provide the ordinary credit card number and verification data. *Id.* After providing this information, the user is provided with a disposable or customized number and/or mailed, provided with, or allowed to activate a disposable or customized card. *Id.*

¹Because *Cohen* is only citable under 35 U.S.C. § 102(c) Applicants do not admit that *Cohen* is in fact prior art to the claimed invention but reserve the right to swear behind *Cohen* if necessary to remove it as a reference.

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This requirement to call or "dial into the credit card company before making a transaction" is reinforced by *Cohen*, which further teaches that "customization (and activation) of the card or a specific credit card number can be in any of the ways known in the art. In a simple method, for example, the user can call the credit card company to customize the card in the manner desired and/or to activate that specific credit card or credit card number. In a variation on this method, the user could be required to call from his or her own phone. See col. 12, lines 34-45.

The user may also be able to dial in over a direct connection and program in the desired characteristics with the user's computer. See col. 12, lines 46-50. In this case, however, the user must be provided with a software program, or the user can access a web site and fill out a form. See col. 12, lines 46-57. *Cohen* therefore teaches that customization and activation of a card or a specific credit card number is achieved by calling the credit card company, for example. In some instances, the user may be required to call from their own phone in order to be verified by "Caller ID." See col. 12, lines 44-45. In each of these cases, however, activation of the disposable number is not achieved through the use of a transaction card. Further in *Cohen*, the credit card company does not receive a communication from a transaction card.

In contrast to the teachings of *Cohen*, claim 1 requires "receiving a communication at the computer from a transaction card". The communication from the transaction card includes the request for activation of the limited-use number. The limited-use number is then activated in response to the communication from the transaction card. *Cohen* does not teach receiving a communication at the computer from a transaction card. Rather, *Cohen* requires the user to call in to the credit card company or to access a web site and fill in a form as discussed above.

In other words, the ability to use a transaction card to activate the limited-use number is not taught or suggested by *Cohen*. Claim 1 requires receiving a communication at the computer

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from a transaction card. Because *Cohen* does not teach or suggest receiving the communication at a computer from a transaction card as illustrated above, *Cohen* cannot teach or suggest the requirement in claim 1 of activating the limited-use account in response to said communication from the transaction card.

For at least these reasons, claim 1 overcomes the art of record and is believed to be in condition for allowance. Claims 2-6 depend from claim 1 and overcome the art for at least the same reasons. For at least the same reasons, independent claim 7 and dependent claims 8-11 also overcome the art of record and are in condition for allowance.

Claim 13 requires activating the limited-use account number in response to a request made by the account holder using a transaction card. As discussed above, the transaction card is not taught or suggested by *Cohen*. Further, claim 13 requires that the transaction card have encoded data that allows the account holder to activate the limited-use account number. This is also not taught or suggested by *Cohen*. Even assuming that *Cohen* did teach such a transaction card, no mention is made of encoded data that allows the account holder to activate the limited-use number. In other words, there is no communication from a transaction card that has encoded data that is included in a request for activation because *Cohen* teaches that a user should call the credit card company or access a website as discussed above.

Further, claim 13 require that the limited-use account number be issued at a computer of an intermediary institution, while the regular account number is issued by a different financial institution. *Cohen* does not teach or suggest that the limited-use account number be issued by one institution and the regular account number be issued by a different financial institution. *Cohen* discloses that the account number and the limited use number are with the same credit card company.

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For at least these reasons, claim 13 also overcomes the art of record and is in condition for allowance. The dependent claims 14-17 overcome the art and are allowable for at least the same reasons.

Similarly, claim 18 is also in condition for allowance for at least the reasons discussed above. The dependent claims 19-21 are likewise believed to be in condition for allowance.

Rejections Under 35 U.S.C. § 103

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cohen*. For at least the reasons discussed above, claim 12 is believed to be in condition for allowance.

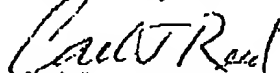
Conclusion

Because August 27, 2005 was a Saturday, this amendment is timely filed on Monday, August 29, 2005 and no extension fees are due.

In view of the foregoing, and consistent with the Examiner Interview, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 29th day of August 2005.

Respectfully submitted,


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